



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,926	06/08/2001	Paul H. Robb	23424-016	2458

29315 7590 07/06/2005

MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON, VA 20190

EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,926

Applicant(s)

ROBB, PAUL H.

Examiner

Kelly Campen

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-25-05 has been entered.

Specification

The abstract of the disclosure is objected to because it includes language that may be implied (see below). Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;

Art Unit: 3624

(4) if a mixture, its ingredients;

(5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Applicant has not given a residence address anywhere in the application papers as required by 37 CFR 1.33(a), which was in effect at the time of filing of the oath or declaration.

A statement over applicant's signature providing a complete residence address is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3624

Claims 1-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims there is recited terms that are indefinite because there is no clear definition of the meets and bounds of the term. The terms include:

"collaborate" "enabling" "to interact" "forum".

In dependant claims there is recited "events" and "actions" which are also terms that are indefinite because there is no clear definition of the meets and bounds of the term.

The terms "client" and "participants" are confusing since the relationship between the two is not recited (i.e.: are the participants clients of the client?).

The term "library of resources" is vague and indefinite since the entire Internet could be defined as such.

The recitations of claims 4 and 18 are confusing as a whole because the interrelationships claimed are not clear.

All claims will be examined as best understood.

All dependant claims that are not vague and indefinite are rejected because they are encompassing a rejected independent claim.

Claims 28-54 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are

Art Unit: 3624

considered apparatus.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-27 and 55-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method consists solely of the manipulation of an abstract idea and is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. In addition, the claim is devoid of any limitation to a practical application in the technological arts. The invention in the **body** of the claim must recite technology. If the invention, in the body of the claim, is not tied to technological art, environment, or machine, the claim is not statutory (see *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001). Also note MPEP 2106 IV 2(b). Examiner notes that this is not a precedential decision but it is being cited for its analysis of whether the claim is in the technological arts.

The term "tool" and "module" may be an abstraction. The term "online is considered trivial per se.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-19, 22-32, 34-46, 49-54, 57-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. (US 5940843).

Zucknovich et al discloses a method for providing a tool with which a client and one or more participants may interact. A client defines a collaboration team comprising one or more participants (col 1 , Lines 50-56). The client submits client data to the tool in a common format (col 5, lines 60-67). The participants comprise one or more entities authorized by the client to participate in the tool, wherein the client also defines the scope of authorization for each participant (col 6, lines 25-30). The client interacts with one or more participants through the tool, wherein interaction among participants

Art Unit: 3624

comprises exchange of client data (col 87, Lines 14-50). The participants may be financial advisors (col 5, lines 55-56).

The client data comprises financial documents as a work product (col 2, Lines 41-50). There is enabled the client to access a client history database wherein the client history database maintains information related to previous actions (col 83, Lines 26-45). A library of resources is disclosed since there is taught access to the Internet. Zucknovich et al does not use the word "forum" to describe what their tool provides.

It would have been obvious to one with ordinary skill in the art to include a common "forum" as describing the tool to Zucknovich et al because Zucknovich et al teach that research providers require interaction with those who desire their work product (col 1, Lines 39-44).

Claims 6, 20-21, 33, 47-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich as applied to claims above, and further in view of Moran (US-6,430,542 B1).

Zucknovich et al does not disclose a calendar function or planning means for enabling participant to formulate a financial plan. Moran discloses a calendar function (fig 37) and a planning means for enabling participant to formulate a financial plan (col 1, lines 21-30).

It would have been obvious to one with ordinary skill in the art to include a calendar function to Zucknovich et al because Moran teaches that planning requires knowing timelines for answering planning questions (col 32, Lines 1 1-30).

It would have been obvious to one with ordinary skill in the art to include planning

Art Unit: 3624

means for enabling participant to formulate a financial plan to Zucknovich et al because Moran teaches that financial advisors provide financial planning (col 1, Lines 25-26) and Zucknovich et al teaches advisors.

Claims 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. as applied to claims above, and further in view of Carter (US 5787175).

Zucknovich et al does not disclose use of "encryption".

Carter discloses encryption of documents (fig 11).

It would have been obvious to one with ordinary skill in the art to include encryption to Zucknovich et al because Carter teaches encryption advantages to control access of documents (col 4, lines 1-18).

Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich et al. as applied to claims above, and further in view of Day et al. (US6243722).

Zucknovich et al does not disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data.

Day et al discloses disclose enabling the client to view participant input wherein participant input comprises one or more or edits, analysis and comments related to client data (col 3, Lines 45-67., col 4, Lines 1-25).

It would have been obvious to one with ordinary skill in the art to include participant input wherein participant input comprises one or more or edits, analysis and comments related to client data because Day et al teaches collaborative efforts require edits, analysis and comments (col 3, lines 45-64, col 4, lines 6-25), and Zucknovich et al

Art Unit: 3624

teaches correction for inaccuracies of client data (col 1, lines 62-67., col 2, lines 1-25).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of copending Application No. 09/732008. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

A "forum" encompasses a "collaboration tool" and a "library of resources" encompasses a "database".

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 4/25/05 have been fully considered but they are not persuasive.

Art Unit: 3624

With regards to applicant's arguments concerning the 35 USC 101 rejection, while applicant did amend the claims in an attempt to overcome the rejection, the issues remain. See above 35 USC 101 rejection for specific citations and reasoning.

With regards to the applicants arguments concerning the 35 USC 112 second paragraph rejections, applicant states he respectfully disagrees with the rejection and states that "the meanings of the terms [that are] indefinite are fully ascertainable through a reading of the claims in light of the specification **and/or** based on the ordinary English language meanings of these terms". Examiner disagrees and continues that the terms are yet to be defined by applicant's arguments as applicant has used "and/or" when defining the terms.

With regards applicants arguments against the 35 USC 103 rejections, since applicant has not argued the 35 USC 103 (a) rejection of claims 6, 20-21, 33, 47-48 as being unpatentable over Zucknovich further in view of Moran (US-6,430,542 B1), Examiner will understand this as admitted prior art.

In response to applicant's argument that Zucknovich et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Zucknovich et al is in the field of applicant's endeavor. Specifically, the system in Zucknovich et al. is capable of performing the function of the instant application regardless of whether it is a financial service provider or other type of service provider is irrelevant.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kelly S. Campen